

Application No.: 10/667,662
Art Unit 2623

Attorney Docket No. 3449-0272P
Supplemental Reply to Office Action dated February 7, 2008
Page 2

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-22 are now present in this application. Claims 1, 11 and 12 are independent.

Reconsideration of this application is respectfully requested.

Rejection Under 35 U.S.C. § 102

Claims 1-22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Daniels (U.S. Patent Application Publication 2003/0074672). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action and is not being repeated here.

A prior art reference anticipates the subject matter of a claim when that reference discloses every feature of the claimed invention, either explicitly or inherently. See *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed Cir. 1997). While, of course, it is possible that it is inherent in the operation of the prior art device that a particular element operates as theorized by the Examiner, inherency may not be established by probabilities or possibilities. What is inherent, must necessarily be disclosed. See *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

During patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed.

EHC/RJW:mmi:jmc

Application No.: 10/667,662
Art Unit 2623

Attorney Docket No. 3449-0272P
Supplemental Reply to Office Action dated February 7, 2008
Page 3

Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

Moreover, as stated in MPEP § 707.07(d), where a claim is refused for any reason relating to the merits thereof, it should be "rejected" and the ground of rejection fully and clearly stated.

Additionally, findings of fact and conclusions of law by the USPTO must be made in accordance with the *Administrative Procedure Act*, 5 U.S.C. § 706(A), (E) (1994). See *Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999).

A claim limitation is inherent in the prior art if it is necessarily present in the prior art, not merely probably or possibly present. See *Rosco v. Mirro Lite*, 304 F.3d 1373, 1380, 64 USPQ2d 1676 (Fed. Cir. 2002). The dispositive question regarding anticipation is whether one skilled in the art would reasonably understand or infer from the prior reference's teaching that every claim feature or limitation was disclosed in that single reference. See *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368, 66 USPQ2d 1801 (Fed. Cir. 2003).

Daniels does not disclose or suggest the features positively recited in claims 1-22. Claim 1, for example, positively recites a combination of features, including separating AV broadcast signals and data broadcast signals from digital television broadcast signals of at least one channel; selectively mixing the AV broadcast signals and the data broadcast signals according to a display setup request inputted by an input unit; providing the selectively mixed signals directly to a first display unit; and providing the selectively mixed signals via a home network to at least one display unit other than the first display unit and other than the input unit. Independent claims 11 and 12 include similar features in a varying scope.

Daniels' discussion of a home network is in terms of using a wireless display terminal as a

EHC/RJW:mmi:jmc

Application No.: 10/667,662
Art Unit 2623

Attorney Docket No. 3449-0272P
Supplemental Reply to Office Action dated February 7, 2008
Page 4

portable digital assistant when it is in range of its "home" multimedia network – see paragraph [0030], for example. Daniels does not explicitly, or inherently (i.e., not just possibly and not just probably, but necessarily) disclose providing the selectively mixed signals directly to a first display and providing the selectively mixed signals via a home network to at least one display unit other than the first display unit and other than the input unit that provides a display setup request, as recited.

Moreover, the reliance of the rejection on seven different paragraphs of Daniels to somehow disclose this claimed combination of features overlooks the fact that Daniels contains no concept of displaying the same selectively mixed signals directly to the first display and also to a second display other than the first display or the input unit, and via a home network, as positively recited in the claimed invention.

Claims 1-11 are method claims that require specific steps to be performed, and Daniels just does not perform the claimed steps.

Moreover, with respect to claims 4, 7 and 18, just because a possibility may exist that Daniels' multiple displays are "capable of" displaying video signals and data simultaneously, or "able to" show multiple channels and data on the same screen, or because two different displays "can tune" to different channels, does not mean that Daniels explicitly or inherently (i.e., necessarily) teaches this, and that is what is required to anticipate the claims. Another way of stating this is that for a claimed feature to be inherently disclosed in an anticipatory manner, the claimed feature has to necessarily occur, and that is not the situation in Daniels with respect to the features positively recited in claims 4, 7 and 18. The claimed invention recited method steps and

EHC/RJW:mmi:jmc

Application No.: 10/667,662
Art Unit 2623

Attorney Docket No. 3449-0272P
Supplemental Reply to Office Action dated February 7, 2008
Page 5

none of the method steps recites being capable of doing something. Again, Applicants stress the fact that claims 1-11 are method claims and require steps to be actively performed

Furthermore, with respect to claims 5, 8, 9, 17 and 19, just because a possibility exists that multiple displays are "capable of" displaying video signals and data simultaneously, or "able to" show multiple channels and data on the same screen, or because two different displays "can tune" to different channels, does not mean that Daniels explicitly or inherently (i.e., necessarily) teaches this, and that is what is required to anticipate the claims.

In other words, the only disclosure of these positively recited method step features is in Applicant's disclosure and this disclosure is not found in Daniels. For this reason, Daniels cannot possibly anticipate the claimed invention.

Similarly, with respect to claim 6, just a possibility may exist that multiple displays are "capable of" displaying video signals and data simultaneously, or "able to" show multiple channels and data on the same screen, or because two different displays "can tune" to different channels, does not mean that Daniels explicitly or inherently (i.e., necessarily) discloses that this, and that is what is required to anticipate the claims. Claim 16, line claims 12-12 and 17-22, are apparatus claims, but these claims positively recite means for performing specific functions, and to anticipate those claims, Daniels has to disclose means that perform the claimed function. However, Daniels does not do this, because Daniels has no concept of performing the claimed functions,

With respect to the apparatus claims, i.e., claims 12-22

Further, with respect to claim 16, just because multiple displays are "capable of" displaying video signals and data simultaneously, or "able to" show multiple channels and data on the same

EHC/RJW:mmi:jmc

Application No.: 10/667,662
Art Unit 2623

Attorney Docket No. 3449-0272P
Supplemental Reply to Office Action dated February 7, 2008
Page 6

screen, or because two different displays "can tune" to different channels, does not mean that Daniels explicitly or inherently (i.e., necessarily) discloses doing this, and that is what is required to anticipate the claims.

For at least these reasons, the Office Action fails to make out a *prima facie* case of anticipation of the claimed invention by Daniels.

Accordingly, reconsideration and withdrawal of this rejection of claims 1-22 are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46, 472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

EHC/RJW:mmi:jmc

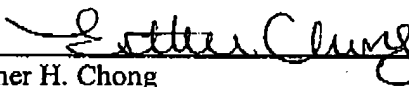
Application No.: 10/667,662
Art Unit 2623

Attorney Docket No. 3449-0272P
Supplemental Reply to Office Action dated February 7, 2008
Page 7

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: August 7, 2008

Respectfully submitted,

By: 
Esther H. Chong
Reg. No.: 40,953
BIRCH, STEWART, KOLASCH & BIRCH, LLP
P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000
Attorney for Applicants

EHC/RJW:mmi:jmc